

REMARKS

Reconsideration and allowance of this application are respectfully requested.

Claims 1-31 stand rejected under 35 U.S.C. 102(e) as being anticipated by Davis (U.S. Patent Application Publication No. 2003/0001846; hereafter “Davis”).

New claims 32-47 are added herein.

Thus, claims 1-47 are all the claims pending in the application.

Applicant respectfully submits that the pending claims define patentable subject matters.

I. Preliminary Matter

As a minor error correction, Applicant corrects a typo “or” between “commemorative” and “the viewing” in the third element of the claim. Applicant replaces the typo with “of”.

II. Analysis of Claim Rejection under 35 U.S.C. 102

Claim 1

In rejecting this method claim, the Examiner simply alleges that most of the claim elements are disclosed by the abstract of Davis except for directing the orderer information to Davis’ paragraph 190.

According to Davis (beyond the abstract), the system therein discloses a method to automatically capture a user-created performance in a movie booth (similar to a photo kiosk) using a video camera, composite/edit the captured performance into a preset template thereby creating a personalized image or video, and allow a user to select and order the image or video.

Since the Examiner does not specifically indicate which image(s) in Davis correspond to the moving images and an image of a desired scene in claim 1, Applicant presumes from the Examiner's rationale of rejecting claims 10 and 12-13 that the Examiner interprets the moving images in claim 1 as the user-created images, i.e., the user's performance captured in video in a movie booth (similar to a photo kiosk).

Basically, the method of claim 1 allows a user (customer) to designate or select an image of a desired scene from moving images (such as movie) and create a commemorative image based on the designated image. Based on this feature, claim 1 is distinguished from Davis as the claimed method enables a user to designate an image of a desired scene from moving images to create a personalized media. In Davis, however, a user is not allowed to designate an image of a desired scene. Rather, the desired scene (performance) is determined by an automated system as specifically shown in paragraph 55. In Davis, the user may be simply allowed to select whether or not to take the video composited/edited into the template after her performance in the movie booth.

In other words, the claimed method explicitly allows a user (who is viewing the moving images) to designate an image out of the same moving images. However, the images from which the user of Davis is to create a personalized media do not provide the user with a choice of a desired scene. The user is to simply accept the directed media. There is no such "an image of a desired scene" as recited in claim 1.

In the meantime, it should also be noted that Davis is basically related to editing a video in which a user himself is on, photographed in a capture booth, to create personalized media. On the contrary, the claimed method provides creation of “a commemorative image on viewing of moving images” from an image of a desired scene designated by the user who is viewing moving images at a movie theatre or the like.

It is well settled that “anticipation requires the presence in a single prior art disclosure of all elements of a claimed invention arranged as in the claim.” Since Davis fails to teach or suggest the feature that allows a user to designate an image of a desired scene, Davis cannot be construed as anticipating claim 1.

Therefore, it is respectfully submitted that claim 1 is not anticipated by Davis.

Claims 2-11 and 13

These claims should be allowable at least by virtue of their dependency from claim 1.

Claim 12

As the Examiner alleges, Davis (paragraph 72) may be interpreted as suggesting image recording of before and after of the designated scene (unstructured part of the user’s performance). However, Davis does not teach display of such unstructured part so as for the user to finally place an order by referring to the display as in claim 12.

Therefore, Applicant respectfully submits that claim 12 should be patentable regardless of its patentability by virtue of its dependency from claim 1.

Claim 14

This claim describes that a commemorative image is made available for the image of frequently designated scenes. To reject this claim, the Examiner applies a frequency with which advertisements (including the selected image) are actually opened when a designated image is emailed to a recipient by a user who first designates the image.

Here, the Examiner's frequency is based on the propensity of the recipient (advertisement target), while the frequency of claim 14 is that of the user. In addition, the commemorative image in claim 14 is not an image made by the user; it is made available prior to designation of the desired scene by the user.

Therefore, Applicant respectfully submits that claim 14 should be patentable regardless of its patentability by virtue of its dependency from claim 1.

Claim 15

Davis appears to suggest the use of a biological reaction of a user to create a matching frame in paragraph 196. However, this disclosure is directed to deciding whether an acceptable image is created or not; it does not teach or suggest designation of a desired scene out of moving images.

Therefore, Applicant respectfully submits that claim 15 should be patentable regardless of its patentability by virtue of its dependency from claim 1.

Claim 16

The Examiner rejects this claim based on Davis paragraph 150 which discloses that the eyes stop moving when the action completes. The attitude of eyeballs described in this claim may appear to be suggested by the cited part of Davis. However, this disclosure does not teach the use of the attitude of eyeballs to designate the image of the desired scene.

Thus, it is respectfully submitted that claim 16 should also so be allowable with claim 15.

Claims 17-31

The Examiner rejects these apparatus claims based on the same rationale for method claims analysis.

Accordingly, Applicant respectfully traverses the Examiner's rejections based on the foregoing reasoning.

III. New Claims

Applicant adds new claims 32-47 to more fully cover various aspects of Applicant's invention as disclosed in the specification and to provide a more general scope of protection.

Applicant respectfully requests the entrance and allowance of these new claims.

V. Conclusion

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

AMENDMENT UNDER 37 C.F.R. § 1.111
US Application No. 09/991,902

Attorney Docket No. Q66497

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,

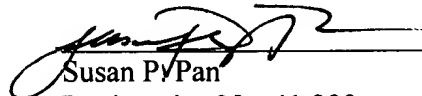
SUGHRUE MION, PLLC
Telephone: (202) 293-7060
Facsimile: (202) 293-7860

WASHINGTON OFFICE

23373

CUSTOMER NUMBER

Date: September 21, 2006


Susan P. Pan
Registration No. 41,239